

REMARKS

I. Status of the Claims

Upon entry of the amendment above, claims 1-18, 20-29, 31, 32, 34-37, and 39-74 will be pending, claims 1, 43, 49, and 71 being independent.

Claims 25-29, 32, 36, 37, stand withdrawn from consideration as being directed to non-elected inventions.

II. Summary of the Office Action

Claims 12, 13, 18, 42, and 49-59 are indicated as being allowable, subject to overcoming alleged indefiniteness set forth in a rejection under 35 USC §112, second paragraph. See Sections 11 and 12 on pages 8 and 9 of the Office action.

Claims 25-30, 32, 33, and 36-38 stand withdrawn from consideration as being directed to non-elected inventions.

The specification is objected to under 35 USC §132 for having alleged to have introduced prohibited "new matter", viz., "the elements can be regarded more generally as tread members." See Section 3 on page 2 of the Office action.

Claims 1-24 and 49-59 are rejected under 35 USC §112, second paragraph, as being indefinite. See Section 5 on page 3 of the Office action.

Claims 1, 2, 5-11, 14-17, 20-24, 31, 34, 35, 39-41, 43-46, and 48 are rejected under 35 USC §102(b) over British Patent No. 2 256 784 (GB '784). See Section 7, beginning on page 5 of the Office action.

Claims 46 and 47 are rejected under 35 USC §103(a) are rejected over GB '784 in view of "Official Notice". See Section 9, beginning on page 7 of the Office action.

Claims 3 and 4 continue to be rejected under 35 USC §103(a) as being unpatentable over GB '784 in view of MONTGOMERY et al. (U.S. Patent No. 4,924,606). See Section 10, on page 8 of the Office action.

III. Summary of the Interview with Examiner

As required by USPTO policy and the Interview Summary (form PTOL-413), the substance in-person interview of May 17, 2004 is here provided.

With regard to a limitation that had appeared near the end of independent claim 43 (revised in the amendment above), Applicants' representative pointed out that "above" was used in the context consistent with a description in the specification, *i.e.*, that the junction zone of the half-soles extends at least partially *above* the reinforcement from the perspective of a bottom view. However, in the amendment to be filed (*i.e.*, the instant amendment), the word "above" will be changed to "beneath", which is taken from the perspective of the sole/boot positioned on top of a support surface. Applicants' representative pointed out that in GB '784, if the peripheral body 63 is to be regarded as a "reinforcement" in the rejection, and if the "fibre reinforced parts 71a and 71b" (see, *e.g.*, page 13, line 15 of GB '784) are to be regarded as "half-soles," the "half-soles" 71a, 71b are clearly *above* the "reinforcement" 63, which is in contrast to claim 43, as now amended.

The indefiniteness rejection, as it applies to claim 49, was discussed. Applicants' representative agreed to amend the claim in the manner suggested by the Examiner, *i.e.*, "at least one reinforcement structure, ~~said one reinforcement structure~~ extending"

Applicants' representative inquired as to the basis for the Examiner's objection to the specification, based upon the allegation that prohibited new matter had been added, for having introduced the expression "tread members" to the specification. Applicants' representative explained that the expression is consistent with the ordinary meaning of the term "tread" as would be understood in particular to those of ordinary skill in the art. In reply, the Examiner agreed that the elements 8 (see Figs. 1, 2, and 5) would likely encompass tread members, he indicated that his objection is based upon the fact that the term "tread" had not been a part of

the original disclosure. Applicants' representative mentioned that he would consider removing the offending expression and replace it (particularly in dependent claims 51 and 52, where the term "tread" had been used) with terminology that was literally used in the originally presented specification. However, he indicated that would not regard any such deletion/amendment as having the effect of giving up or disclaiming any particular function of the members such as those identified by reference numeral 8 in the original specification and drawings.

Applicants' representative brought up the fact that dependent claim 19 ("A sole according to claim 1, wherein the front portion comprises at least one element for coupling to a gliding support.") had not been rejected on the basis of prior art, while dependent claim 9 ("A sole according to claim 1, wherein at least one of the front or rear half-soles is constituted by at least one piece for guiding and for connecting to a sports apparatus.") had been including in a rejection under 35 USC §102(b). The Examiner explained that the claims differ in that claim 9 had used the expression "sports apparatus" and that claim 19, in contrast, had used the expression "gliding support." The Examiner explained that the former (claim 9) would encompass, *e.g.*, the spikes/cleats of the shoe of GB '784 (see page 6, line 2 of the Office action).

IV. Summary of Amendment

Paragraphs 0052, 0071, and 0077 are amended for clarification and, with regard to paragraph 0077, to overcome an objection under 35 USC §132.

Independent claim 1 has been amended by incorporating therein the subject matter of claim 19 (which has been canceled), and the expression "preferably, by cementing and/or riveting and/or welding" has been deleted, the latter for the purpose of overcoming an issue raised in a rejection under 35 USC §112, second paragraph.

Claims 4, 10, 13, 22-29, and 34 have been changed to improve their forms.

Claim 5 has been amended to change "junction/overlapping zone" to "junction zone" and to change its dependency from claim 1 to claim 3, so that the expression will have literal antecedent basis, not to change the scope of the claim at all, thereby resolving an issue raised in the §112 rejection.

Claim 8 has been amended to place it, again, in dependent form and to add the limitation that the coupling element is adapted to couple the sole to a *gliding* sports apparatus.

Claim 9 has been amended by having been rewritten in independent form and by having added the limitation that the half-soles have at least one piece for connecting to a *gliding* sports apparatus.

Claim 12 has been amended to resolve issues raised in the §112 rejection and to improve its form.

Non-elected independent claim 30 and claims 33 and 38, the latter having depended from claim 30, have been canceled.

Independent claim 43 has been amended by changing "above" to "beneath" near the end of the claim.

Independent claim 49 has been amended by overcoming an issue raised in the §112, second paragraph rejection, mentioned above in connection with the summary of the interview. In addition, claim 49 has been amended by adding that the reinforcement structure comprises a "composite material" and by relegating the limitation referring to the reinforcement structure being more rigid than the constituent materials of the front and rear sole portions to new dependent claim 67.

Claims 51 and 52 have been amended by having deleting the term "tread" and by adding to claim 51 (from which claim 52 depends) "said members adapted to cooperate with a support for the sole", which finds literal support, *e.g.*, in original paragraph 0100 of the specification.

Lastly, new claims 60-74 have been added, of which claim 71 is independent.

V. Response to Office Action**A. Withdrawal of the Objection to the Specification**

In response to the objection to the specification, Applicants have amended paragraph 0077 to delete the final sentence that had been added. Accordingly, withdrawal of the objection is requested.

B. Withdrawal of Rejection Under 35 USC §112, Second Paragraph

In response to the rejection of claims 1-24 and 49-59 under 35 USC §112 and, as explained in the "Summary of the Amendment" section above, Applicants have presented amendments to the claims which are believed to resolve all the issues raised by the Examiner.

In view of the amendment, reconsideration and withdrawal of the rejection is kindly requested.

If any issue of indefiniteness were to remain, or if the Examiner would prefer different wording in any of the claims, he is invited to contact Applicants' undersigned representative.

C. Withdrawal of Rejections Under 35 USC §102(b) and §103(a)

Applicants request that the rejections under both 35 USC §102(b) and 35 USC §103(a) be withdrawn at least for the following reasons, as well as for the reasons presented in their previous response.

Independent claim 1 has been amended to add the limitation from claim 19 (now canceled), which claim had not been rejected, of "at least one element for coupling to a gliding support" (such as a cross country ski, for example).

In addition, claim 9 has been amended by being rewritten in independent claim and by also having added thereto the subject matter of claim 19.

As explained above in connection with the interview with the Examiner, independent claim 43 has been amended by having changed the word "above" to "beneath."

In contrast to claim 43, in GB '784, if the peripheral body 63 is to be regarded as a "reinforcement" in the rejection, and if the "fibre reinforced parts 71a and 71b" (see, *e.g.*, page 13, line 15 of GB '784) are to be regarded as "half-soles," the "half-soles" 71a, 71b are clearly *above* the "reinforcement" 63.

D. Request for Rejoinder of Claims 25-29, 32, 36, 37

Upon the allowance of independent claim 1, Applicants request that claim 25, as well as the claims depending from claim 25 (*viz.*, claims 26-29, 32, 36, and 37), which currently stand "withdrawn" from consideration as being directed to non-elected inventions, be "rejoined" as provided for in Section 821.04 of the Manual of Patent Examining Procedure.

E. New Claims

As mentioned above, new claims 60-74 have been added.

Dependent claims 60-70 should be allowed at least for reasons that parent claims 1, 43, and 49 should be allowed. In addition, these claims add additional subject matter to the claimed invention.

New claim 60 depends from claim 1 and further specifies that the front and rear half-soles comprise two distinct non-unitary portions assembled together in the junction zone, the one reinforcement extending longitudinally through the junction zone. This claim is intended to be as precise as possible that the half-soles are not manufactured as one distinct piece, but that they are connected together, which enables one to realize the advantage, for example, of creating differently sized soles from the same sized half-soles.

New claims 61-63 also depend from claim 1 and, collectively, retain the subject matter that has been deleted from the end of claim 1, *viz.*, that the front and rear half-soles are assembled to one another in the junction zone at least by cementing, riveting, or by welding, respectively.

Claim 64, depending from claim 8, further specifies that the gliding sports apparatus is a cross-country ski, and wherein the coupling element is at least one transverse rod mounted in the front portion of the sole.

Claim 65, depending from claim 43, further specifies that one of the front and rear half-soles comprises at least one portion constructed to guide and to connect the sole to a *gliding* sports apparatus.

Claim 66, depending from claim 49, further limits the composite material of the reinforcement structure to comprise a material that increases torsional rigidity of the outer sole compared to torsional rigidity without the composite material.

Claim 67, as mentioned above, also depends from claim 49 and further specifies that the reinforcement structure comprises a structure more rigid than constituent materials of each of the front and rear sole portions.

Claim 68, also depending from claim 49, specifies that the composite material comprises a matrix with embedded reinforcing fibers.

Claim 69, also depending from claim 49, specifies that the reinforcement structure comprises a composite laminate comprising one or more textile layers embedded in a matrix.

Claim 70 depends from dependent claim 51 and specifies that wear-resisting pads are positioned on respective ones of the members for improving adherence of the sole on the support.

Claim 71 is an independent claim which includes much of the subject matter of independent claim 1. For example, claim 71 describes a sole for a sports boot which includes front and rear portions, with the rear portion being more rigid in longitudinal bending than the front portion; the front portion comprising a reinforcement and a front half-sole affixed to the

reinforcement; the rear portion comprising a rear half-sole affixed to the reinforcement; the front half-sole and the rear half-sole being assembled together in a junction zone; the front half-sole further comprising a member for coupling the sole to a sports apparatus; and each of the front and rear half-soles comprising at least one downwardly extending member adapted to cooperate with a support for the sole.

If the elements 71a, 71b of GB '784 were considered to be "half-soles", they do not include downwardly extending members. Instead, the cleats 65 are connected to the peripheral member 63, which has been identified in the rejections based upon GB '784 as a "reinforcement."

Claim 72 depends from claim 71 and further adds the recitation of "wear-resisting pads positioned on respective ones of said downwardly extending members for improving adherence of the sole on the support."

Claim 73, also depending from claim 71, further adds "at least one element for coupling the sole to a *gliding* support."

Claim 74, also depending from claim 71, further specifies that the sole is for a cross-country shoe and adds the limitation for a coupling device to connect only a front of the sole to a cross-country ski.

SUMMARY AND CONCLUSION

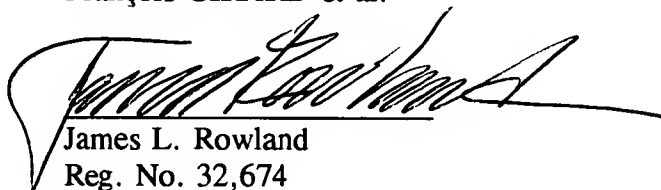
The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of claim fees. Any additional fee required for entry of this reply can be charged to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that would render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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May 19, 2004
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